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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Ritsuko Tanaka

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STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

RETTA, YEHDEGA

ART UNIT

PAPER NUMBER

3622

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/001,992	Applicant(s) TANAKA ET AL.	
	Examiner Yehdega Retta	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-10,13-18 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-10, 13-18 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in response to amendment filed October 22, 2008. Applicant amended claims 1, 3-10, 13-18, 21 and canceled claims 22-25. Claims 1, 3-10, 13-18 and 21 are currently pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-10, 13-16, 18 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Orikomio (<http://www.dnp.orikomio.com>), as disclosed by INTERNET Watch "Dai Nippon Printing Co., Ltd, Starts Internet Circular Service "Orikomio"" (hereinafter Orikomio) in view of Applicant's background and further in view of Bunney et al. (US 6,564,217 B1).

Regarding claims 1, 18 and 21, Orikomio teaches a database which registers a contract users having a subscriber contract with a newspaper; an advertisement preparation unit an advertisement requested by an advertiser, publishing the prepared advertisement on a Web page and preparing and publishing a "*non-contract user utilizable contents*" including local area information; an advertisement utilization unit which, when a user is identified as a contract user registered in the database allows the contract user to view said advertisement on the Web page.

Orikomio (as also discloses by Applicant) teaches with respect to an advertising system of a local area contacting type utilizing the Internet, the Internet inserted-bill supplying service,

Art Unit: 3622

"Orikomio!.RTM.", which allows the user to view advertisements, etc. of a desired area by allowing the user to input the postal code of the corresponding area, has started in a limited area (<http://www.dnp-oriokomio.com/CGI/pilot/home.cgi>). Further Orikomio teaches in this system, advertisements and recruitment information that have been registered by advertisers such as retail outlets with the payment of advertising fees are placed on the Web pages for three days so that general users and registered users are allowed to view desired pages for free of charge, and this system is expected as an advertising system of the local area contacting type. However Orikomio failed to teach *when a viewing request from a user identified as a non-contract user not registered in said database is received, prohibits publishing of said advertisement on said non-contract use page and after allowing the non-contract user to view the non-contract user utilizable contents open to the public permitting subscription contract registration processing by presenting an application page for subscribing with said newspaper dealer*. Bunney teaches when a user is determined to be a new user allowing the user to view the home page which includes content that is open to the public (it is also possible for the user to visit sites without first registering and not all facilities of the service are available) and providing a link to a registration page and once the user is registered the user is required to login (see fig. 5 and col. 6 line 30 to col. 7 line 33). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to require Orikomio's subscriber to register for the online publication or newspaper in order to exclude non registered user access to the service as taught in Bunney (see col. 6 lines 30-54).

Examiner would like to point out that whether the database includes a registered user for the delivery of newspaper or for access to a web page does not make patentable difference since

Art Unit: 3622

the language “to deliver a newspaper to the contract user” is just an intended use and does not change the registration process.

Regarding claims 3-5, Orikomio teaches inputting an electronic medium advertisement from an advertiser and places the resulting advertisement on said Web page, and also converts a medium advertisement from an advertiser to electronic data, and places the resulting advertisement on said Web page; preparing an advertisement requested by an advertiser or a Web page of the advertiser (Applicant discloses that in this system, *advertisements and recruitment information that have been registered by advertisers* such as retail outlets with the payment of advertising fees are *placed on the Web pages* for three days so that general users and registered users are allowed to view desired pages for free of charge); wherein, when a user views said advertisement on the privileged Web page, said advertisement utilization unit gives a privilege offer by a newspaper dealer or an advertiser to the subscription user viewing said advertisement (general users and registered users allowed to view the web page which includes the advertisement and recruitment information).

Regarding claims 7, 8 and 15, Orikomio does not explicitly teach wherein based upon a linking request specified by the subscription user, said advertisement utilization unit makes a link to a Web page of the advertiser. However official notice is taken that is old and well known in the art to provide a link to advertiser web site in the art of e-commerce. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention for the advertiser of Orikomio to provide link to the web site so the user could access additional information for the advertisement or a purchase opportunity for the user to purchase the advertised product. Claim 8 recites “makes access to a Web page of the advertiser managed by a newspaper dealer on a same

Art Unit: 3622

chain in a different area”. Whether the advertiser is in the same chain in the same area or different area does not make any difference since the link provided is to any advertiser who is advertising on the Web page.

Claims 6, 9-11, 13, 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Orikomio (<http://www.dnp.orikomio.com>), as disclosed by INTERNET Watch “Dai Nippon Printing Co., Ltd, Starts Internet Circular Service “Orikomio”” (hereinafter Orikomio) in view of Applicant’s background and further in view of Bunney et al. (US 6,564,217 B1) further in view of Kent US 2002/0040374.

Regarding claims 6, 10-11 and 16, Orikomio does not teach storing advertisement selection information specified and desired by the subscription user, and delivers an advertisement corresponding to the corresponding advertisement selection information by mail or facsimile, is taught in Kent ([0072], [0083], and [0036]). Orikomio also does not teach automatically edits a Web page dedicated to a subscriber user based upon advertisement selection information specified by the subscriber and stores or downloads the resulting data to a user device, it is taught in Kent (see [0072], [0083], [0036]). It would have been obvious to one of the ordinary skill in the art at the time of the invention to modify Orikomio online publication to be able to be mailed as in Kent for the intended purpose of allowing the subscriber to also have a hard copy of the newspaper as in Kent. It would also have been obvious to one of ordinary skill in the art at the time of the invention to edit the Web page for the intended purpose of providing customized or personalized printed material with their personal content and advertising preferences, as taught in Kent (see [0009]).

Art Unit: 3622

Regarding claim 9, placing local information other than advertisements, such as bulletin boards and link collections on said Web page, and said advertisement utilization unit publicizes local information to contractor users and non-contract users of said database is inherent feature to Orikomio's Web page. These features are also taught by Kent (see fig.2). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include such information since this is the standard practice for publishing newspapers.

Regarding claim 13, Orikomio does not explicitly teaches, wherein said advertisement utilization unit retrieves subscription users who need to update the contract from the database, and displays the necessity of updating the contract at the time of visiting said privileged Web page, it is taught in Kent (see [0075, 0076]). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide an application page for newspaper subscriber contract to Orikomio's Web page, as in Kent in order to have user's profile for the intended purpose of providing a customized or personalized Web page (publication).

Regarding claim 14, Orikomio/Kent does not teach preparation of a guide map upon a request from the user. Official Notice is taken that is old and well known in the art of WWW to provide a preparation of a guide map and to display it. On-line advertisers provide a program such as Mapquest to provide a map of a location, including the current location of the user and the destination specified by the user, in order to find the geographical location of the advertiser. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide such feature, in Orikomio/Kent web page, since Internet users use on-line map, such as Mapquest, to find the location of the advertiser providing the advertisement.

Claim 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Orikomio in view of Bunney et al. (US 6,564,217 B1) further in view of Fredrickson Pub. No. US 2002/0019768 (hereinafter Fredrickson).

Regarding claim 17, Fredrickson teaches collecting registers visiting information of the user for each advertisement visit and determines and settles publication fee based upon the results of the survey (see 0050, 0065, 0066-0086). It would have been obvious to one of ordinary skill in the art at the time of the invention to include such feature, in Orikomio/Bunney, in order to charge advertisers based upon the visits, as taught in Fredrickson.

Response to Arguments

Applicant's arguments with respect to claims 1, 3-10, 13-18 and 21 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 3622

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR

/Yehdega Retta/
Primary Examiner, Art Unit 3622